



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,898	04/06/2001	Maroka Ueda	205727US-2	6383

22850 7590 03/13/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,898

Applicant(s)

UEDA ET AL.

Examiner

Thierry L. Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,9,11,13-16 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11,13-16 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2624

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 1/20/06.
- Claims 1-2, 4-6, 8-9, 11, 13-16, and 21-25 are pending; claims 3, 7, 10, 12, and 17-20 have been canceled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/06 has been entered.

Duplicate Claims

Applicant is advised that should claims 1, 8, 13 be found allowable, claims 21, 23, and 25 (respectively) will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. *When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording*, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 8, 15, 21, 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 2624

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner is unable to locate a portion of the original filed specification that teaches newly added feature/limitation "thereby not visible in a superimposed image of the at least two elements" as cited in claims 1, 8, 15, 21, and 23. The applicants are advised to point out a specific portion of the original filed specification that teaches the above features if the applicants believe such teachings are incorporated.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 15, 21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unable to locate any relevant meaning to the term "not visible". If the applicants have an alternate meaning to the term "not visible", clarifications are required.

Claims 1, 8, 15, 21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Limitations/features "the controller is configured to send the edited first image information to the information processing apparatus *for printing*" is unclear to the examiner. Is the "information processing apparatus" that performs the printing or the printing device (i.e. printer) that performs the printing? According to original filed specification, "information processing apparatus" is a client device (i.e. host computer, personal computer, image processing device) and it is not a printing device (i.e. printer). Clarification is appreciated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6, 8-9, 11, 13-16, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka (US 6327049).

Regarding claim 1, Ohtsuka discloses an image processing apparatus (*laboratory print apparatus, fig. 2*) comprising:

- a communication unit (*network 10, fig. 1*) configured to communicate with an information processor apparatus (*client computer 5, figs. 1-2*), the information processing apparatus configured to operate on image information;
- a storage configured to store first image information (*template server 1 for storing plurality of high resolution templates 3, fig. 2*) which represents at least one element (*sample template 3 includes plurality of elements, i.e. texts, fig. 1*); and
- a controller configured to send second image information (*low resolution template 13 is sent to user terminal, fig. 2, col. 7, lines 1-42*) to the information processing apparatus (*user terminal 5, figs. 2-3*), said second image information represents the at least one element (*low resolution template 13 includes plurality of elements, i.e. texts, fig. 2*) and an amount of the second image information is smaller than an amount of the first image information (*it is well known in the art that high resolution template is higher/larger than the low resolution template, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50*), wherein
- the controller is further configured to acquire result information (*acquires order file 6 from client apparatus 5, fig. 3, col. 8, lines 30-35*), the result information being a result of an operation (*wherein order file 6 includes user's processed/edited template, i.e., user carries out processing such as pasting the image on the template or insertion of an illustration or characters, col. 7, lines 50-65 and col. 8, lines 5-8*) which is executed on the sent second image information (*executes on low resolution template downloaded from server, col., 7, lines 50-65 and col. 8, lines 5-8*) on the information processing apparatus (*performs via using client apparatus 5, fig. 1-2, col. 7, lines 50-65, an example of print order 4 sent from client including processed low resolution template is shown in fig. 4, col. 8, lines 30-35*), the result information indicating an order (*table 3, col. 11, shows an example of an order file submits from client, col.*

Art Unit: 2624

8, *lines 30-35*) of the at least one element in the second image information in a direction perpendicular (*i.e. rotation of 90 degrees, table 8, col. 13, lines 15-30*) to a display screen;

- the controller is further configured to edit the first image information (*laboratory server apparatus for editing high resolution templates with respect to print order file along with finishing options sent from the client apparatus, fig. 2-4, cols. 7-8 and col. 10, lines 42-60*), wherein the first image information stored in the storage is expanded (*expands the high resolution templates via image server, fig. 3, cols. 7-8*), the first image information is edited according to the acquired result information (*editing according to image processing requests includes in order file 6, table 3, and col. 10, lines 42-60*) so that if at least two elements superimpose each other (*i.e. image superimpose with texts as shown in fig. 6*), a portion of the image information covered by any of the at least two elements, thereby not visible in a superimpose image of the at least two elements (*image processing methods such as mask processing for an overlapping portion to mask invisible superimpose image, col. 2, lines 44-49, other image processing methods are shown in fig. 3 for image enhancement, col. 10, lines 42-60*) is not included by the edited first image information; and

Ohtsuka teaches a printer connected to a personal computer 5 (col. 8, lines 36-40), but does not explicitly teach and/or suggest the controller from print laboratory system is further configured to send the edited first image information to the information processing apparatus for printing.

Network 10 (fig. 1, col. 6, lines 50-55) of Ohtsuka is an Internet communication network, which well known in the art is a bi-directional communication network, therefore, it would have obvious to one of ordinary skill in the art to have controller from print laboratory system to send the edited/processed image back to client apparatus for printing (via connected printer as taught by Ohtsuka, col. 8, lines 36-40), by doing so, it eliminates the waiting time and shipping costs of having the processed image printed by the laboratory and then shipped to the user.

Regarding claim 2, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein the controller is further configured to execute at least one of a moving process, an enlargement process, a reduction process and a deletion process (*i.e. image*

Art Unit: 2624

processing specification, tables 3-8, cols. 11-13) on the at least one element during said editing of the first image information in the intermediate process.

Regarding claim 4, Ohtsuka further discloses the image processing apparatus according to claim 1, wherein a network is configured to connect among the image processing apparatus, the information processing apparatus and other information processing apparatuses (network 10, fig. 1), and the controller is configured to broadcast the first image information which is edited and composed to a plurality of desired information processing apparatuses (i.e. apparatus 1 and 5, fig. 1) of the information processing apparatus and the other information processing apparatuses.

Regarding claim 5, satellite communication network is well known and wide available in the art.

Regarding claims 8-9: Claims 8-9 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-2; therefore, claims 8-9 are rejected for the same rejection rationale/basis as described in claims 1-2 above.

Regarding claim 15: Claims 15 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claim 15 would be rejected using the same rationale as in claims 1.

Regarding claim 21 recites limitations that are similar and in the same scope of invention as to those in claim 1 above; therefore, claim 21 is rejected for the same rejection rationale/basis as described in claim 1. Also see duplicate claims as described above.

Regarding claim 22, Ohtsuka further teaches the image processing apparatus according to claim 21, wherein the result information represents identification of the at least one elements and each location thereof (table 6, col. 12).

Regarding claims 23-24: Claims 23-24 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 21-22; therefore, claims 23-24 are rejected for the same rejection rationale/basis as described in claims 21-22 above.

Regarding claim 6, Ohtsuka discloses an image processing apparatus (*laboratory print apparatus, fig. 2*) comprising:

- a communication unit (*network 10, fig. 1*) configured to communicate with an information processing apparatus (*client computer 5, figs. 1-2*) configured to process first image information and second image information (*low resolution template and high resolution template, fig. 3*) in association with each other, both of the first image information and the second image information representing at least one element (*sample template 3 includes plurality of elements, i.e. texts, fig. 1*) and the amount of the second image information being smaller (*it is well known in the art that high resolution template is higher/larger than the low resolution template, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50*) an amount that of the first image information;
- an image processor (*ref. 7, fig. 3*) configured to receive the second image information (*order file with low resolution template, fig. 3*) from the information processing apparatus via the communication unit, configured to display (*display, fig. 3*) the received second image information on a given display device, configured to receive an operation instruction for the displayed second image information (*order file include plurality of instructions, table 3, col. 11*), configured to process the displayed (*display, fig. 3*) second image information according to the operation instruction;
- an output controller (*laboratory system 2, fig. 3*) configured to receive the first image information (*high resolution image data and template, fig. 3*) via the communication unit, the first image information being edited (*editing according to image processing requests includes in order file 6, table 3, and col. 10, lines 42-60*) according to the result information on the information processing apparatus, and configured to cause a given printing device (*print output, fig. 3*) to print the received first image information, and

Art Unit: 2624

- wherein the operation instruction includes adding process for adding additional information (*i.e. image superimpose with texts as shown in fig. 6*) to the displayed second image information, the image processor saves the additional information, and the output controller executes a superimpose process (*i.e. image superimpose with texts as shown in fig. 6*) for the received first image information and the saved additional information and cause the given printing device (*print output, fig. 3*) to print a result of the superimpose process.

Ohtsuka teaches a printer connected to a personal computer 5 (col. 8, lines 36-40), but does not explicitly teach and/or suggest sending result information representing the processed and displayed second image information to the information processing apparatus.

Network 10 (fig. 1, col. 6, lines 50-55) of Ohtsuka is an Internet communication network, which well known in the art is a bi-directional communication network, therefore, it would have obvious to one of ordinary skill in the art to result information representing the processed and displayed second image information to the information processing apparatus for printing (via connected printer as taught by Ohtsuka, col. 8, lines 36-40), by doing so, it eliminates the waiting time and shipping costs of having the processed image printed by the laboratory and then shipped to the user.

Regarding claim 11: Claim 11 is the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claim 6; therefore, claim 11 is rejected for the same rejection rationale/basis as described in claim 6 above.

Regarding claim 16: Claims 16 corresponds to claim 6 except computer readable memory medium for storing program is claimed rather that printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claim 16 would be rejected using the same rationale as in claims 6.

Regarding claim 13, Ohtsuka teaches an image information distributing method (*distribution, fig. 3*) applied to a network system (*network system, fig. 1*) including a first image processing apparatus (*laboratory apparatus, fig. 3*) and a second image processing apparatus (*client apparatus, fig. 3*), the first image processing apparatus and the second image processing

Art Unit: 2624

apparatus being interconnected (*network, fig. 1*) with each other, the first image processing apparatus configured to store first image information in a compressed (*compressed format, col. 13, lines 40-45*) and second image information, both of the first image information and the second image information representing at least one element (*sample template 3 includes plurality of elements, i.e. texts, fig. 1*), an amount of the second image information being smaller than an amount of the first image information (*it is well known in the art that high resolution template is higher/larger than the low resolution template, figs. 2-4, col. 6, lines 60-67 to col. 7, lines 1-50*), the method comprising:

- sending the second image information (*low resolution template 13 is sent to user terminal, fig. 2, col. 7, lines 1-42*) to the second image processing apparatus from the first image processing apparatus;
- displaying (*displaying via user terminal 5, fig. 3*) the second image information on a given display device of the second image processing apparatus;
- receiving an operation instruction (*order file include plurality of instructions, table 3, col. 11*) for the displayed second image information in the second image processing apparatus;
- processing (*editing according to image processing requests includes in order file 6, table 3, and col. 10, lines 42-60*) the displayed second image information according to the operation instruction in the second image processing apparatus;
- sending result (*sending order file 6 include plurality of instructions along with processed low resolution template, table 3, col. 11*) information representing the processed and displayed second image information to the first image processing apparatus from the second image processing apparatus, wherein when the operation instruction includes adding (*i.e. image superimpose with texts as shown in fig. 6*) process for adding additional information to the displayed second image information, wherein the additional information is saved in the second image processing apparatus;
- editing (*editing according to image processing requests includes in order file 6, table 3, and col. 10, lines 42-60*) the first image information, in the first image processing apparatus, according to the result information in an intermediate process where the first image information stored in the storage is expanded;

Art Unit: 2624

- executing a superimpose process (*i.e. image superimpose with texts as shown in fig. 6*) for the received first image information and the saved additional information in the second image processing apparatus; and
- causing a given printing device (*col. 8, lines 35-42*) of the second image processing apparatus to print a result of the superimpose process.

Ohtsuka teaches a printer connected to a personal computer 5 (*col. 8, lines 36-40*), but does not explicitly teach and/or suggest sending the edited first image information to the second image processing apparatus from the first image processing apparatus.

Network 10 (*fig. 1, col. 6, lines 50-55*) of Ohtsuka is an Internet communication network, which well known in the art is a bi-directional communication network, therefore, it would have obvious to one of ordinary skill in the art to send the edited first image information to the second image processing apparatus from the first image processing apparatus for printing (via connected printer as taught by Ohtsuka, *col. 8, lines 36-40*), by doing so, it eliminates the waiting time and shipping costs of having the processed image printed by the laboratory and then shipped to the user.

Regarding claim 14, Ohtsuka further teaches the image information distributing method according to claim 13, wherein the network system includes other image processing apparatuses (*fig. 3*), and the sending of the edited first image information includes broadcasting the first image information which is edited and composed (*see claim 13 for more details*) to a plurality of desired information processing apparatuses of the second image processing apparatus and the other processing apparatuses.

Regarding claim 25: Claim 25 is the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claim 13; therefore, claim 25 is rejected for the same rejection rationale/basis as described in claim 13 above.

Response to Arguments

Applicant's arguments, see pages 14-17, filed 1/20/06, with respect to the rejection(s) of claim(s) 1, 8, 15, 21, and 23 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretations of previous applied art reference.


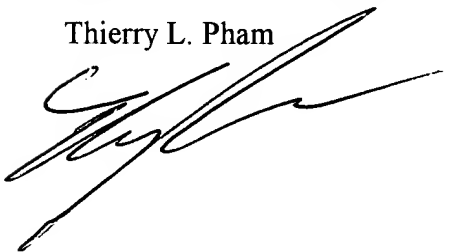
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER